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EXAMINER

HOLMES, MICHAEL B

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 12/04/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,361

Applicant(s)

CRONIN, JOHN E.

Examiner

Michael B. Holmes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1, 7, & 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.



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Examiner's Detailed Office Action

1. This action is responsive to application **09/781,361**, filed **February 12, 2001**.
2. **Claims 1-12** have been examined.

Information Disclosure Statement

3. Examiner acknowledges applicants' submission of prior art and information disclosure. Nevertheless, applicant is respectfully remind of the ongoing Duty to disclose 37 C.F.R. 1.56 all pertinent information and material pertaining to the patentability of applicant's claimed invention, by continuing to submitting in a timely manner PTO-1449, Information Disclosure Statement (IDS) with the filing of applicant's of application or thereafter.

Drawings

4. The formal drawings have been reviewed by the United States Patent & Trademark Office of Draftperson's Patent Drawings Review. Form PTO-948 has been provided.

Specification

5. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is required in correcting any errors of which applicant may become aware in the specification. Moreover, applicant will need to provide the application number for (ipCG-506, ipCG-507, ipCG-508, ipCG-509, & ipCG-519).

Claim Objections

6. **Claims 1, 7, & 12** are objected to because of the following informalities: **Claim 1** refers to an "iterative processing" of step (c) i.e., (c) iterating (b)(i) to (b)(ii), of which are not present. Examiner will not speculate as to applicant's intentions. Examiner interprets this as a typo, claim 11, has the missing iteration. Appropriate correction is required. **Claim 7** has an improper dependency i.e., claim 7 is dependent upon it self. Examiner interprets applicant intention was to have claim 7, dependent upon claim 6. Appropriate correction is required. Finally, **Claim 12** is dependent upon a claim that does not exist i.e., claim 13. Examiner interprets "Alternate Questioning Themes" referring to claim 11, as applicant's intentions. Appropriate correction is required.

Claim Interpretation

7. Office personnel are to give claims their "**broadest reasonable interpretation**" in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA

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1969). See *also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322(Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). *see* MPEP § 2106

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. The invention as disclosed in **claims 1-12** is directed to nonstatutory subject matter i.e., an *abstract idea* i.e., they are not limited to a *practical application* in the technological arts. The claims appear to be a method performed on a computer, however, no computer-readable medium has been disclosed by applicant. As a result, examiner will not speculate as to the intended meaning, because applicant discloses no “certain substances” that have been “transformed or reduced” that is, applicant claims disclose no *specific* computer-readable medium.

10. Furthermore, there is no manipulation of *specific* data representing physical objects or activities constituting what one may classify as pre-computer activity, nor does applicant disclose any *specific* independent physical acts being performed by the invention constituting

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post-computer activity. Finally, the claims merely manipulate abstract ideas in general without limitation to a practical application where “certain substances” are transformed or reduced on a computer-readable medium.

11. **Therefore, claims 1-12 are rejected under 35 USC § 101.**

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. **Claims 1-12** are rejected under 35 U.S.C. 112, first paragraph. Specifically, if the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112.”); *In re Kirk*, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) MPEP 2107.01 (IV)

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pressman, David, 1937 - PATENT IT YOURSELF (6th ed., 1997), (Nolo Press Berkeley)

in view of

From Patent to Profit, Secret & Strategies For The Successful Inventor, Bob DeMatteis (1998),
Publisher: Avery.

Regarding Claim 1:

Pressman teaches,

A method of facilitating conception of inventive concepts by an inventor, the method comprising any one or more of the following:

(a) interviewing an inventor to identify or otherwise characterize a basic invention [(**You Don't Have to Use a Patent Attorney, page 1 / 1**, "*In this view, it's almost a universal misconception that one must use a patent attorney to get a valid patent ...* ")];

Pressman does not teach,

(b) facilitating conception of inventive elements using creative stimulus comprising how-type questions relating to the functioning of the invention identified in (a), however, *DeMatteis* teaches (b) facilitating conception of inventive elements using creative stimulus comprising how-type questions relating to the functioning of the invention identified in (a), [(**Table of Content, 2. Your Inventive Strategy, page 6 of 14, How to get Prototypes Made at Little or No Cost to You** & **3. Developing Your Invention, page 7 of 14, "How to Make Your Inventions "People Friendly"**)] It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matters pertains, to employ the questioning methodology i.e., specifically how-type questions, because when you are seeking specific information, about a process as complex, lucrative, time consuming, and expensive (i.e., for

some inventors) as the inventive process from start to completion.. One of the most efficient, and comprehensive ways of obtaining the desired information is to use who, what, why, where, when, and how-type questions until they are exhausted as a means to an end, for the purpose of knowing your audience. Discover as much as possible about your audience before you prepare what you are going to say, continue to learn who they are even as you step to and through the problem. When you learn as much as you can about your audience, you'll become more comfortable with them and knowledgeable about them. Rapport will be established., and (c) iterating (b)(i) to (b)(ii) [(see claim objection)].

Regarding Claim 2:

Pressman teaches,

The method of claim 1 wherein the basic invention is identified and/or characterized by accomplishing any one or more of the following steps:

- (a) facilitating drawing of a diagram of the basic invention [**G. Software and Other Computer-Related Inventions, page 8 / 7 – 8 / 9, FIG 8B-Software Flowcharts (see page 8 / 8, right column, second paragraph, “Fig 8B shows adequately detailed flowcharts ... and explains exactly how to implement the flowchart.”)**];
- (b) facilitating definition of one or more elements of the basic invention [**G. Software and Other Computer-Related Inventions, page 8 / 7 – 8 / 9 (see page 8 / 9, Specific, item (I) “Adjust value ...”)**]; and
- (c) facilitating definition of problem(s) solved and/or problems to be solved by the basic invention. [**G. Software and Other Computer-Related Inventions, page 8 / 7 – 8 / 9 (see page 8 / 9,**

Specific, item (f) “Solve ...”]

Regarding Claim 3:

Pressman teaches,

The method of claim 1 further comprising communicating to the inventors any one or more concepts selected from the group consisting of :

- (a) concept of an invention being a function of the problem to be solved by the basic invention, the element(s) that comprise the basic invention, and how the elements are connected or interrelated [**G. Software and Other Computer-Related Inventions, page 8 / 7 – 8 / 8 (left column, fifth paragraph** “*You should explain in the specification how to implement the listing ... (for instance, a MDI interface” and “a laser printer” “)*];
- (b) a ladder of abstraction [**1. Machine Sketches, page 8 / 10 (“If your machine is complicated, you should show an exploded view of it, as in Fig. 8D.”)**];
- (c) prior art (**C. The Novelty and Unobviousness Requirement, page 1 / 4 “prior art ...”**), novelty (**C. The Novelty and Unobviousness Requirement, page 1 / 4 “...novelty requirement ...”**), nonobviousness (**C. The Novelty and Unobviousness Requirement, page 1 / 4 “...unobvious ...”**), inventive step (**B. Inventing by Problem Recognition and Solution, page 2 / 2, “Now that you know what an invention ... 1) recognizing a problem, and 2) fashioning a solution.”**) and bar dates (**Experiment exception vi. Prior Sale or On-Sale Status in the U.S, page 5 / 12-5 / 13 “35 U.S.C. 102 statutory bar”**);
- (d) inventorship (**A. What I mean by “Invention” page 2 / 2 “For the purpose of this book ... useful.”**); and

(e) enablement and written description. [**G. Software and Other Computer-Related Inventions, page 8 / 7 –8 / 8** (see page 8 / 8, left column, second paragraph, “*The special consideration applicable to software inventions is in meeting the full disclosure requirement. ... That is, make absolutely sure it contains a “full, clear, concise, and exact” description of the invention and how to make and use it.*”)]

Regarding Claim 4:

Pressman teaches,

The method of claim 1 further comprising documenting and/or recording output of any of steps (a)-(c) [**Chapter 3, Documentation Can Be Vital, page 3 / 1** (see B. Documents Are Vital to the Inventive Process 3/2 & C. Documentation is Vital to Prove Invention 3/3)].

Regarding Claim 5:

Pressman teaches,

The method of claim 1 further comprising documenting and/or recording administrative information. [**Documentation Can Be Vital, Chapter 3, (D. Documents Are Vital to the Invention Process, page 3 / 2** “*It takes more than a good idea to sustain the invention process. It is absolutely essential to keep good, sound, records, for the following reasons: ... “*”)]

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. **Claims 6-10** are rejected under 35 U.S.C. 102(b) as being anticipated by

Pressman, David, 1937 - PATENT IT YOURSELF (6th ed., 1997), (Nolo Press Berkeley).

Regarding Claim 6:

Pressman teaches,

A method of "growing" a basic invention, the method comprising:

(a) identifying the basic invention [(**The Science and Magic of Inventing, page 2 / 2** "*Inventing provides things that enhance ... it could turn out to be something great!*")];

(b) selecting a questioning theme [(**B. Inventing by Problem Recognition and Solution, right column, second paragraph, page 2 / 4** "*So, if you either don't have an invention or want to make some new one, ... What problems do you encounter and how do you solve them?*")];

(c) identifying an aspect of the basic invention by one or more inventors that falls within the questioning theme [(**B. Inventing by Problem Recognition and Solution, right column, fourth paragraph, page 2 / 4** "*Also, remember that sometimes the "problem" may be the ordinary way something has been done for years, ...thereby creating the massaging effect.*")];

(d) identifying enhancements to the basic invention by the one or more inventors, wherein the enhancements relate to the aspect of the invention [(**B. Inventing by Problem Recognition and**

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Solution, right column, page 2 / 3 “5. Wiz-z-er™ Gyroscopic Top ...”];

(e) repeating (c) - (d) one or more times for alternate aspects of the basic invention within a questioning theme [(B. **Inventing by Problem Recognition and Solution, right column, page 2 / 3 - 2 / 4, “6. Dolby® ...”**) and (“**13. Grocery Shopping Cart ...”**)]; and

(f) repeating (b) - (e) one or more times for alternate questioning themes. [(B. **Inventing by Problem Recognition and Solution, right column, second paragraph, page 2 / 4 “So, if you either don’t have an invention or want to make some new one, ...Ask yourself if something can be done more easily, cheaply, simply, or reliable? ”**), (B. **Inventing by Problem Recognition and Solution, right column, page 2 / 3 “7. Xerography ...Copying documents ...”**), (B. **Inventing by Problem Recognition and Solution, right column, page 2 / 3 “7. Xerography ...The charging of a photosensitive surface ...deposit black powder on a sheet ...”**), (B. **Inventing by Problem Recognition and Solution, right column, page 2 / 3 “2. Intermittent Windshield Wipers In drizzles, the slowest speed ...slow sweep was annoying”**), (B. **Inventing by Problem Recognition and Solution, right column, page 2 / 3 “2. Intermittent Windshield Wipers Provide a “drizzle” setting where ... but paused after each sweep”**)]

Regarding Claim 7:

Pressman teaches,

The method of claim 6 wherein the alternate questioning themes comprises one or more themes selected from the group consisting of:

(a) disadvantages of the basic invention [(**Inventor’s Commandment #5, page 4 / 2 “Don’t spend significant time or money on your creation until you have thoroughly evaluated it for**

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commercial potential, including considering all of its advantages and disadvantages.”)];

(b) advantages of the basic invention [(**Inventor’s Commandment #5, page 4 / 2** “*Don’t spend significant time or money on your creation until you have thoroughly evaluated it for commercial potential, including considering all of its advantages and disadvantages.”*)];

(c) operability issue(s) [(**E. Solving Creativity Problems, page 2 / 6** “*Unfortunately, hardly any invention ever works right ... ” I failed my way to success.*” “)];

(d) other ways to solve a same problem [(**D. Making Ramifications of Your Invention, page 2 / 6** “*Once you’ve made an invention ... Why ramify?*”)];

(e) licensing strategies [(**G. Licensing of Inventions – An Overview, page 16 / 6** “*Usually, the owner of a patent application or patent needs to allow others to make or sell the patented invention ...*”)]; and

(f) identification of competitors and/or competitive products. [(**D. Making Ramifications of Your Invention, page 2 / 6** “*Once you’ve made an invention ... Why ramify?* item (1), (2), ...”)]

Regarding Claim 8:

Pressman teaches,

The method of claim 7 further comprising prior to the "growing" of the basic invention, communicating to the inventor(s) any one or more concepts selected from the group consisting of:

(a) concept of an invention being a function of a problem to be solved by the basic invention, element(s) that comprise the basic invention, and how the element(s) are connected or inter-related [**The Science and Magic of Inventing (Inventor’s Commandment #2, page 2 / 2**

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“To invent successfully, be aware of problems you encounter. Also, take the time to study and investigate the practicality of new phenomena that occur by accident or flash of insight. Persevere with any development you believe has commercial potential.””];

(b) a ladder of abstraction [(2. **How to Enter Technical Information in the Note Book**, page 3 / 6 *“Fig. 3A is an example of a properly completed notebook ... then go back and transcribe your description.”*)];

(c) prior art (C. **The Novelty and Unobviousness Requirement**, page 1 / 4 *“prior art ...”*), novelty (C. **The Novelty and Unobviousness Requirement**, page 1 / 4 *“...novelty requirement ...”*), nonobviousness (C. **The Novelty and Unobviousness Requirement**, page 1 / 4 *“...unobvious ...”*), inventive step (B. **Inventing by Problem Recognition and Solution**, page 2 / 2, *“Now that you know what an invention ... 1) recognizing a problem, and 2) fashioning a solution.”*), and bar dates (Experiment exception vi. **Prior Sale or On-Sale Status in the U.S**, page 5 / 12-5 / 13 *“35 U.S.C. 102 statutory bar”*);

(d) inventorship (A. **What I mean by “Invention”** page 2 / 2 *“For the purpose of this book ... useful.”*); and

(e) enablement and written description. [G. **Software and Other Computer-Related Inventions**, page 8 / 7 –8 / 8 (see page 8 / 8, left column, second paragraph, *“The special consideration applicable to software inventions is in meeting the full disclosure requirement. ... That is, make absolutely sure it contains a “full, clear, concise, and exact” description of the invention and how to make and use it.”*)]

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Regarding Claim 9:

Pressman teaches,

The method of claim 7 further comprising documenting and/or recording output of any of steps

(a)-(f). [**Chapter 3, Documentation Can Be Vital, page 3 / 1** (*see B. Documents Are Vital to the Inventive Process 3/2 & C. Documentation is Vital to Prove Invention 3/3*)]

Regarding Claim 10:

Pressman teaches,

The method of claim 7 further comprising documenting and/or recording administrative information. [(**B. Documents Are Vital to the Invention Process, page 3 / 2** "*It takes more than a good idea to sustain the invention process. It is absolutely essential to keep good, sound, records, for the following reasons: (1), (2), (3), (4) ...*")]

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. **Claims 11-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pressman, David, 1937 - PATENT IT YOURSELF (6th ed., 1997), (Nolo Press Berkeley)

in view of

From Patent to Profit, Secret & Strategies For The Successful Inventor, Bob DeMatteis (1998),
Publisher: Avery.

Regarding Claim 11:

Pressman teaches,

A method of facilitating conception of inventive concepts by an inventor, the method comprising any one or more of the following:

(a) communicating to the inventors concepts selected from the group consisting of (i) concept of an invention being a function of a problem to be solved by the basic invention, element(s) that comprise the basic invention, and how the element(s) are connected or interrelated [**The Science and Magic of Inventing (Inventor's Commandment #2, page 2 / 2** "*To invent successfully, be aware of problems you encounter. Also, take the time to study and investigate the practicality of new phenomena that occur by accident or flash of insight. Persevere with any development you believe has commercial potential.*")]; (ii) a ladder of abstraction [**1. Machine Sketches, page 8 / 10** ("*If your machine is complicated, you should show an exploded view of it, as in Fig. 8D.*")]; (iii) prior art (**C. The Novelty and Unobviousness Requirement, page 1 / 4** "*prior art ...*"), novelty (**C. The Novelty and Unobviousness Requirement, page 1 / 4** "*...novelty requirement ...*"), nonobviousness (**C. The Novelty and Unobviousness Requirement, page 1 / 4** "*...unobvious ...*"), inventive step (**B. Inventing by Problem Recognition and Solution, page 2 / 2**, "*Now that you know what an invention ... 1) recognizing a problem, and 2) fashioning a solution.*"), and bar dates (**Experiment exception vi. Prior Sale or On-Sale Status in the U.S, page 5 / 12-5 / 13** "*35 U.S.C. 102 statutory bar*"); (iv)

inventorship **A. What I mean by “Invention”** page 2 / 2 *“For the purpose of this book ... useful.”*); and (v) enablement and written description [**G. Software and Other Computer-Related Inventions**, page 8 / 7 –8 / 8 (*see* page 8 / 8, left column, second paragraph, *“The special consideration applicable to software inventions is in meeting the full disclosure requirement. ... That is, make absolutely sure it contains a “full, clear, concise, and exact” description of the invention and how to make and use it.”*)];

(b) defining detail of the basic invention the defining detail of the basic invention comprises any one or more of the following: (i) interviewing an inventor to identify or otherwise characterize a basic invention [(**You Don’t Have to Use a Patent Attorney**, page 1 / 1, *“In this view, it’s almost a universal misconception that one must use a patent attorney to get a valid patent ... ”*)]; ; and (iii) repeating (b)(i) invention [(**You Don’t Have to Use a Patent Attorney**, page 1 / 1, *“In this view, it’s almost a universal misconception that one must use a patent attorney to get a valid patent ... ”*)] to (b)(ii); [(*see* below)]

(c) growing the basic invention by a method comprising any one or more of the following steps: (i) identifying the basic invention; [(**The Science and Magic of Inventing**, page 2 / 2 *“Inventing provides things that enhance ... it could turn out to be something great!”*)] (ii) selecting a questioning theme; (iii) identifying an aspect of the basic invention that falls within the questioning theme; (iv) identifying enhancements to the basic invention by the inventor(s), wherein the enhancements relate to the aspect of the invention; (v) repeating (c)(iii) - (c)(iv) one or more times for alternate aspects of the basic invention a questioning theme; and (vi) repeating (c)(ii) - (c)(v) one or more times for alternate questioning themes;

(d) documenting and/or recording output of any of steps (b)(i)-(b)(iii) and (c)(i)-(c)(vi)

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[**Chapter 3, Documentation Can Be Vital, page 3 / 1** (see B. Documents Are Vital to the Inventive Process 3/2 & C. Documentation is Vital to Prove Invention 3/3)]; and (e) documenting and/or recording administrative information. [**Documentation Can Be Vital, Chapter 3, (D. Documents Are Vital to the Invention Process, page 3 / 2** “*It takes more than a good idea to sustain the invention process. It is absolutely essential to keep good, sound, records, for the following reasons: ... “*”)]

Pressman does not teach,

(b)(ii) facilitating conception of inventive elements using creative stimulus comprising how-type questions relating to the functioning of the invention identified in (b)(i), however, *DeMatteis* teaches (b)(ii) facilitating conception of inventive elements using creative stimulus comprising how-type questions relating to the functioning of the invention identified in (b)(i), [(**Table of Content, 2. Your Inventive Strategy, page 6 of 14, How to get Prototypes Made at Little or No Cost to You**” & **3. Developing Your Invention, page 7 of 14, “How to Make Your Inventions “People Friendly”**)] It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matters pertains, to employ the questioning methodology i.e., specifically how-type questions, because when you are seeking specific information, about a process as complex, lucrative, time consuming, and expensive (i.e., for some inventors) as the inventive process, from start to completion. One of the most efficient, and comprehensive ways of obtaining the desired information is to use who, what, why, where, when, and how-type questions until they are exhausted, as a means to an end, for the purpose of knowing your audience. Discover as much as possible about your audience before you prepare

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what you are going to say, continue to learn who they are even as you step to and through the problem. When you learn as much as you can about your audience, you'll become more comfortable with them and knowledgeable about them. Rapport will be established., and (c) iterating (b)(i) to (b)(ii). [(see above)]

Regarding Claim 12:

Pressman teaches,

The method of claim 12 wherein the alternate questioning themes comprise one or more themes selected from the group consisting of:

- (a) disadvantages of the basic invention [**(Inventor's Commandment #5, page 4 / 2 "Don't spend significant time or money on your creation until you have thoroughly evaluated it for commercial potential, including considering all of its advantages and disadvantages."**)];
- (b) advantages of the basic invention [**(Inventor's Commandment #5, page 4 / 2 "Don't spend significant time or money on your creation until you have thoroughly evaluated it for commercial potential, including considering all of its advantages and disadvantages."**)];
- (c) operability issues [**(E. Solving Creativity Problems, page 2 / 6 "Unfortunately, hardly any invention ever works right ... " I failed my way to success. " "**)];
- (d) other ways to solve a same problem [**(D. Making Ramifications of Your Invention, page 2 / 6 "Once you've made an invention ... Why ramify?"**)];
- (e) licensing strategies [**(G. Licensing of Inventions – An Overview, page 16 / 8 "Usually, the owner of a patent application or patent needs to allow others to make or sell the patented invention ... "**)]; and

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(f) identification of competitors and/or competitive products. [(D. Making Ramifications of Your Invention, page 2 / 6 “Once you’ve made an invention ... Why ramify? item (1), (2) ...”)]

Conclusion

20. The prior art made of record and (listed of form **PTO-892**) not relied upon is considered pertinent to applicant’s disclosure as follows. Applicant or applicant’s representative is respectfully reminded that in process of patent prosecution i.e., amending of claims in response to a rejection of claims set forth by the Examiner per Title 35 U.S.C. The patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and any objections made. Moreover, applicant or applicant’s representative must clearly show how the amendments avoid or overcome such references and objections. *See 37 CFR § 1.111(c).*

Correspondence Information

21. Any inquiries concerning this communication or earlier communications from the examiner should be directed to **Michael B. Holmes** who may be reached via telephone at **(703) 308-6280**. The examiner can normally be reached Monday through Friday between 8:00 a.m. and 5:00 p.m. eastern standard time.

If you need to send the Examiner, a facsimile transmission regarding After Final issues, please send it to **(703) 746-7238**. If you need to send an Official facsimile transmission, please send it to **(703) 746-7239**. If you would like to send a Non-Official (draft) facsimile transmission the fax is **(703) 746-7240**. If attempts to reach the examiner by tele-

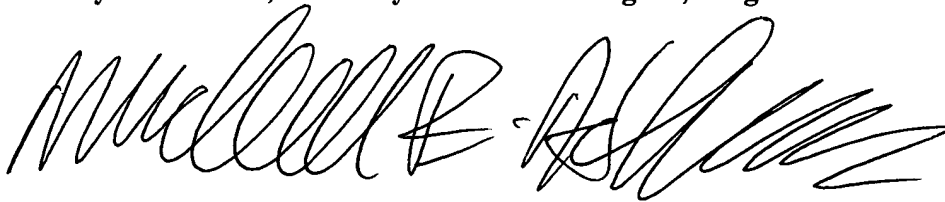
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phone are unsuccessful, the **Examiner's Supervisor, Anil Khatri**, may be reached at **(703)**

305-0282.

Any response to this office action should be mailed too:

Director of Patents and Trademarks Washington, D.C. 20231. Hand-delivered responses should be delivered to the Receptionist, located on the fourth floor of **Crystal Park II, 2121 Crystal Drive Arlington, Virginia.**

A handwritten signature in black ink, appearing to read 'Michael B. Holmes', with a stylized flourish at the end.

Michael B. Holmes

Patent Examiner

Artificial Intelligence

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United States Department of Commerce

Patent & Trademark Office